

**REMARKS**

Claims 1-20 are pending in this application.

Claims 1-20 have been rejected.

No claims have been allowed.

Claims 1-3, 5-9, 12-15 and 18-20 have been amended.

Claims 1-20 remain in the application.

Reconsideration of Claims 1-20 is respectfully requested.

**I. IN THE CLAIMS**

Independent Claims 1 and 5 have been amended to recite limitations commensurate with the scope of, and to more clearly claim, the Applicant's invention. Dependent Claims 2, 3, 6-9, 12-15 and 18-20 have been amended solely to provide correct antecedent support.

**II. REJECTION UNDER 35 U.S.C. § 103**

In the June 7, 2004, Office Action the Examiner rejected Claims 1-20 under 35 U.S.C. § 103(a) as being unpatentable over United States Patent No. 6,411,306 to Miller et al. ("*Miller*") in view of United States Patent No. 5,237,417 to Hayashi ("*Hayashi*"). The Examiner asserted, in essence, that most of the elements recited in Claim 1 are disclosed in the *Miller* reference and that the *Hayashi* reference discloses indicator means for presenting a level indicator that indicates the

parameter adjustments made by the Applicant's invention. The Applicant respectfully traverses the Examiner's rejections based on the *Miller* reference and the *Hayashi* reference.

During *ex parte* examinations of patent applications, the Patent Office bears the burden of establishing a *prima facie* case of obviousness. MPEP § 2142; *In re Fritch*, 972 F.2d 1260, 1262, 23 USPQ2d 1780, 1783 (Fed. Cir. 1992). The initial burden of establishing a *prima facie* basis to deny patentability to a claimed invention is always upon the Patent Office. MPEP § 2142; *In re Oetiker*, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992); *In re Piasecki*, 745 F.2d 1468, 1472, 223 USPQ 785, 788 (Fed. Cir. 1984). Only when a *prima facie* case of obviousness is established does the burden shift to the applicant to produce evidence of non-obviousness. MPEP § 2142; *In re Oetiker*, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992); *In re Rijckaert*, 9 F.3d 1531, 1532, 28 USPQ2d 1955, 1956 (Fed. Cir. 1993). If the Patent Office does not produce a *prima facie* case of unpatentability, then without more the applicant is entitled to grant of a patent. *In re Oetiker*, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992); *In re Grabiak*, 769 F.2d 729, 733, 226 USPQ 870, 873 (Fed. Cir. 1985).

A *prima facie* case of obviousness is established when the teachings of the prior art itself suggest the claimed subject matter to a person of ordinary skill in the art. *In re Bell*, 991 F.2d 781, 783, 26 USPQ2d 1529, 1531 (Fed. Cir. 1993). To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable

expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed invention and the reasonable expectation of success must both be found in the prior art, and not be based on an applicant's disclosure. MPEP § 2142.

The Applicant respectfully submits that the Patent Office has not established a *prima facie* case of obviousness with respect to the Applicant's invention in view of the *Miller* reference and the *Hayashi* reference.

The Applicant respectfully directs the Examiner's attention to amended independent Claim 1, which contains the unique and novel limitations emphasized below:

1. (Currently Amended) An apparatus for processing signals, comprising parameter control means for controlling a parameter of said signals, said parameter control means being adapted to compute adjustments to said parameter as a function of one of: a current ambient factor and a property of said signals, wherein the apparatus further comprises indicator means for presenting a level indicator which is indicative of said computed adjustments. (*Emphasis added*)

Amended independent Claim 5 recites analogous limitations. The Applicant respectfully asserts that the unique and novel limitations of Claims 1 and 5 are not disclosed, suggested, or even hinted at in the *Miller* reference or the *Hayashi* reference, or in the combination of the *Miller* reference and the *Hayashi* references.

The Office Action acknowledges that the *Miller* reference does not disclose an "indicator means for presenting a level indicator, indicative of the adjustments that have been made." (June 7, 2004, Office Action, page 3, lines 7-8). The Applicant agrees that *Miller* does not describe an

indicator means as claimed. The Office Action goes on to state that the *Hayashi* reference, at various places, discloses an apparatus for displaying television receiver “operational parameters”, “control data” and “current setting values” for adjustment parameters. (June 7, 2004, Office Action, page 3, last paragraph). The Office Action finally asserts that it would have been obvious to one of ordinary skill in the art to modify the system of *Miller* by the teachings of *Hayashi* “in order to give the viewer or user a visual feedback or indication of the level or amount of adjustment that has been made to the receiver’s monitor or the TV screen.” (June 7, 2004, Office Action, page 4, first paragraph). The Applicant respectfully traverses this assertion of the Examiner.

The Applicant agrees that in the *Hayashi* reference, information displayed on the screen is best characterized as parameter data, control data or setting values. Specifically, *Hayashi* states that “controller 11 transmits control signals for adjusting the brightness, for example, on the screen to the first and second video signal processing circuits 4 and 9, while transmitting control signals for adjusting the level bar indication for brightness by one step to the character signal generating circuit 7.” Thus, the *Hayashi* reference makes it clear that what is displayed on the screen is indicative of a control signal value applied to video signal processing circuits. As such, the *Hayashi* reference does not teach presenting a level indicator which is indicative of computed adjustments to a signal parameter, as recited in amended independent Claims 1 and 5.

Furthermore, assuming, without admitting, that one of ordinary skill in the art was motivated to combine the teachings of the *Miller* and *Hayashi* references, the Applicant respectfully asserts that the resulting combination still would not suggest all the claimed limitations. Because the *Hayashi*

reference clearly teaches displaying an indication of a control signal applied to a video processing circuit, the *Miller-Hayashi* combination would display an indication of the readings from surround luminance sensor 16 and display illumination sensor 14. Such a system would not suggest presenting a level indicator indicative of computed adjustments to a signal parameter, as recited in amended independent Claims 1 and 5.

Finally, the Applicant respectfully asserts that the Examiner has inappropriately applied hindsight when combining the teachings of the *Miller* reference and the *Hayashi* in order to arrive at the claimed invention recited in independent Claims 1 and 5. The teaching of providing an indicator means for presenting a level indicator which is indicative of computed adjustments to a signal parameter comes from the Applicants' patent application, rather than from the prior art.

For these reasons, the proposed *Miller-Hayashi* combination fails to disclose, teach, or suggest the Applicant's invention as recited in amended independent Claims 1 and 5 (and their dependent claims).

Furthermore, the Applicant respectfully directs the Examiner's attention to dependent Claim 2, which contains the unique and novel limitations emphasized below:

2. (Previously Presented) An apparatus as claimed in claim 1, further comprising user control means for setting a preferred parameter level to be input into said parameter control means, wherein said preferred parameter level is selected by a user from a plurality of parameter levels, said parameter control means being adapted to compute said adjustments as a function of said preferred parameter level and said one of: a current ambient factor and a property of said signals.  
(*Emphasis added*)

Dependent Claim 6 recites analogous limitations. The Applicant respectfully asserts that the unique and novel limitations of Claims 2 and 6 are not disclosed, suggested, or even hinted at in the *Miller* reference or the *Hayashi* reference, or in the combination of the *Miller* reference and the *Hayashi* references.

The Office Action asserts that the default values described in the *Miller* reference at column 5, lines 20-23, teach the preferred parameter level recited in Claim 2. The Office Action further states that the recited limitation of computing signal parameter adjustments as a function of the preferred parameter level and a current ambient factor or signal property is described in *Miller* at steps S9 and S10 of Figure 5 and at column 5, lines 42-67. The Applicant respectfully traverses these assertions.

The stored default value for display luminance is compared (step S5) to an initial reading from display illumination sensor 14 (step S4), and the comparison used in deciding whether to make an initial calculation of display device luminance (step S6). Significantly, the default value for display luminance is not used in the calculation in step S6, described by the equation at column 5, line 32. Similarly, the stored default value for surround luminance is not used in the calculation of image contrast in step S9, described at column 5, lines 47-65. Thus, the *Miller* reference does not teach computing adjustments to a signal parameter as a function of a preferred parameter level, as recited in dependent Claims 2 and 6. The Applicant respectfully asserts that the *Hayashi* reference does nothing to overcome this shortcoming.

For these reasons, the Applicant respectfully submits that amended independent Claims 1 and 5 (and Claims 2-4 and 6-20 depending therefrom) are patentable, and requests that the rejections of Claims 1-20 under 35 U.S.C. § 103(a) be withdrawn. The Applicant respectfully requests that Claims 1-20 be passed to issue.

The Applicant denies any statement, position or averment of the Examiner that is not specifically addressed by the foregoing argument and response. The Applicant reserves the right to submit further arguments in support of his above stated position as well as the right to introduce relevant secondary considerations including long-felt but unresolved needs in the industry, failed attempts by others to invent the invention, and the like, should that become necessary.

**SUMMARY**

If any issues arise, or if the Examiner has any suggestions for expediting allowance of this application, the Applicant respectfully invites the Examiner to contact the undersigned at the telephone number indicated below or at *wmunck@davismunck.com*.

No fees are believed to be necessary. However, in the event that any fees are required for the prosecution of this application, please charge any necessary fees to Davis Munck Deposit Account No. 50-0208.

Respectfully submitted,

DAVIS MUNCK, P.C.

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